

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Reissue Application of:
BILL L. DAVIS and JESSE S. WILLIAMSON

For Reissue of U. S. Patent 5,630,363
Issued May 20, 1997
Serial No. 08/515,097

Filing Date: May 20, 1999

#25
Group Art Unit. 2854

Serial No.: 09/315,796

Examiner: S. Funk
J. Hiltien

For: **COMBINED LITHOGRAPHIC/
FLEXOGRAPHIC PRINTING
APPARATUS AND PROCESS**

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SUMMARY OF INTERVIEW FOR MAY 9, 2000 UNDER 37 C.F.R. §1.133

TO: Honorable Commissioner
Patents and Trademarks
Washington, D.C. 20231

Sir:

On May 9, 2000, the initial portion of Reissue Applicants' Interview with the Examiner was conducted. Attending the interview was Examiner Funk, Reissue Applicants' expert Raymond J. Prince, and the undersigned.

I.

Reissue applicants' counsel indicated that, to the best of his knowledge, all the objections to the specification at column 3, line 59 and col. 4, lines 46-49, and the rejections to claims 12, 19-20, 22, 44-46, 49, 53, 55, 57-58, 60, 62-63, 65, 72, 78, 82 and 85-87 under 35 U.S.C. §112, second paragraph, had been corrected. Reissue applicants' counsel noted that a request had been submitted to transfer the old drawings from the '363 file wrapper to the reissue application file to cure the objections alleged by the patent office draftsman.

II.

Reissue applicants' counsel argued that submission of the Supplemental Joint Reissue Declaration and Amended Cut-up Specification cured any problems under Rule 175. Reissue Applicants' counsel maintained that the reissue oath originally submitted complied with new Rule 175, but was amended as the Examiner wished in an abundance of caution. Counsel pointed out the differences between regulations concerning the reissue oath submitted before the

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rule changed in late 1997, and what was required under the new rule (eff. December 1, 1997). The Examiner agreed with counsel concerning the Rule changes and did not pursue the alleged defective oath problem.

III.

The Examiner indicated that under his interpretation of PTO Rule 121, in particular Rule 121(b)(2)(i)(c), the amendments to claims 44-46, 49, 53, 55, 57-58, 60, 62-63, 65, 72, 78, 82 and 85-87 newly presented by this reissue must be incorporated as part of the claim without underlining or bracketing and, under the Rule, the claims as amended needed to be resubmitted without bracketing. Reissue applicants' counsel indicated that such an interpretation was contrary to other examiners in the office, but that the Examiner's wishes would be complied with. The Examiner indicated no more amendments by way of cut-up specifications would be necessary.

IV.

Reissue Applicants' counsel pointed out that both EP 741,025 (A2) and U.S. Patent 5,960,713 were unavailable as references. Counsel argued that the '025 European application was not a patent, and not available under 35 U.S.C. §102(e) as of its priority date under the Hilmer doctrine (*In re Hilmer*, 359 F.2d 859, 149 USPQ 480 (C.C.P.A. 1966)). The Examiner accepted this argument.

Reissue Applicants' counsel then argued that, at best, the '713 patent was only entitled to its October 2, 1995 filing date in view of the extent of lack of overlap with serial no. 08/435,798, both in the specification and drawings, and that the thrust of the two specifications (serial no. 08/435,798 for the cantilevered device and serial no. 08/538,422 for the "double bump" issued device) were different. The Examiner, who was non-committal, indicated that the matter should be thoroughly researched, and indicated while the text of the '713 and serial no. 08/435,798 were not similar, there were "words in common". Reissue Applicants' counsel argued that "words in common" was insufficient as a matter of law, and that the '798 specification had to place the artisan "in possession of the ['713] claimed invention". Reissue Applicants' counsel argued that it was clear the '798 application had not placed the artisan in possession of the '713 claimed "double bump" device as of May 4, 1995. Reissue Applicants' counsel agreed to further brief the matter for the supplemental paper to be submitted with the Rule 121 amendments.

V.

Reissue Applicants' counsel also argued that, moreover, the 08/435,798 process disclosure, to the extent relevant, was overcome by derivation from reissue applicants, pointing to the two **Bird** and one **Baker** declarations. The Examiner indicated that the matter should be briefed concerning the requirements of an allegation of derivation.

VI.

Expert Prince strenuously maintained that the perfecting claims were supported by (a) the "perfecting" language in col. 2, (b) the references to "printing over" in col. 4, and (c) the multitudinous use throughout the specification of the term "continuous in-line process". The Examiner was non-committal concerning the reference to the term "printing over", but agreed that if the term "continuous in-line process" meant to one of ordinary skill in the art a printing process with perfecting as an option, then the rejection would be withdrawn. He requested expert Prince to find an article in the trade supporting Mr. Prince's position.

Mr. Prince indicated he would conduct the requested research. Reissue Applicants and the Examiner agreed that a supplemental paper would be submitted with the requested changes under Rule 121 and the showing requested of Mr. Prince, if available, and the requested briefing.

Respectfully submitted,



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TOGETHER WITH FEE

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Reissue Application of

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For Reissue of U. S. Patent 5,630,363
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APPARATUS AND PROCESS**

Group Art Unit: 2854
Examiner: S. Funk
J. Hilten
8-2-00
L. Spruel

CERTIFICATE OF SERVICE

I hereby certify that the following documents and things were served on Protestors' counsel by delivering a true and correct copy thereof to the offices of Protestors' counsel by depositing in first class mail on the 28th day of July, 2000, addressed as follows:

William D. Harris, Jr.
LOCKE LIDDELL & SAPP, LLP
2200 Ross Ave., Suite 2200.
Dallas, Texas 75201

1. Summary of Interview for May 9, 200 Under 37 C.F.R. §1.133
 2. Submission of File History, U.S. Patent No. 5,960,713

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SUBMISSION OF FILE HISTORY, U.S. PATENT 5,960,713

TO: Honorable Commissioner
Patents and Trademarks
Washington, D.C. 20231

Sir:

Attached hereto is an uncertified copy of three file histories: serial nos. 08/435,798 filed May 4, 1995; 08/538,422 filed October 2, 1995; and 09/136,901 mentioned on the face of U.S. Patent No. 5,960,713, employed by the Examiner in his first Office Action mailed February 9, 2000.

Access to Serial No. 08/435,798 was granted to Reissue Applicants assignee on June 2, 2000. Tabs 1-25 pertain to serial no. 08/435,798 filed May 4, 1995 of which the majority of the pending claims stand rejected before the Board of Appeals as of the date these documents were received by the undersigned in early June, 2000. Reissue Applicants maintain that since the bulk of the specifications and drawings of serial no. 08/435,798 were not carried forward into Serial No. 08/538j,422, DeMoore cannot be allowed the benefit of the May 4, 1995 filing date for the '713 patent. See In re Wertheim, 646 F.2d 527, 537, 208 U.S.P.Q. 554, 564 (C.C.P.A. 1981); In re Lund, 376 F.2d 1982, 153 U.S.P.Q. 625 (C.C.P.A. 1967); and Ex parte Stalego, 154 U.S.P.Q. 52 (Bd. App. 1966).

Examination of serial no. 08/538,422 shows that the application was under final rejection (**Tab 35**), of all claims, including §112, first paragraph rejection of same claims. Although a

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Notice of Appeal was filed, DeMoore elected to amend his application and file a continuation-in-part on August 19, 1998 (**Tab 44**).

The CIP oath (also part of **Tab 44**) does not show a provision for the signature of one of the applicants, John Bird. Moreover, the oath does not list the published foreign counterparts of serial no. 08/435,798 (including EP 741,025 (A2) in November 1996) although a claim to serial no. 08/435,798 was made by amendment the same day. Counterparts of serial no 08/435,798 were also published in Japan, another pre-examination publication country.

Reissue Applicants contend that because of the acquiesced final rejection, and the amendment specification in August 1998, DeMoore by law cannot be given the October 2, 1995 date. Lund. The issue is moot as the October 2, 1995 is junior to Reissue Applicants, and the '713 patent is clearly unenforceable because of the CIP oath problems.

DeMoore did not even cite the highly material '363 patent to his '713 examiner until on or after he paid the issue fee, despite the fact he allegedly (DeMoore's version) knew about the '363 as of "December 1998 or January 1999" (**Tab 55**). Because DeMoore was clearly not entitled to the May 4, 1995 filing date, the '363 became prior art to the '713 chain, and withholding the '363 until the close of examination constitutes inequitable conduct.

Respectfully submitted,

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FILE HISTORY FOR U.S. PATENT NO. 5,960,713

- I. File History of Serial No. 08/435,798 Filed May 4, 1995 (Filing Date claimed in August 1998 by DeMoore disputed by Davis, et al.)

<i><u>Item No.</u></i>	<i><u>Description</u></i>	<i><u>Filing Date</u></i>
1	Application Serial No. 08/435/798 and accompanying transmittal papers	5/4/95
2	Office Action (restriction requirements) Claims 1-23 - Group I Claims 24-34 - Group II	3/7/96
3	Election of Inventions - Without Traverse (Group I)	6/11/96
4	Attorney Change of Address	4/22/96
5	Transmittal of Information Disclosure States ("IDS") and IDS	6/24/96
6	Transmittal of Supplemental Disclosure Statement ("SIDS") and SIDS	6/26/96
7	Office Action	8/19/96
8	Amendment	1/23/97
9	[Final] Office Action	4/23/97
10	Petition Requesting Consideration of Information Disclosure Statement ("IDS") and IDS	6/17/97
11	PTO Letter [Allowing Entry of IDS]	7/21/97
12	Notice of Appeal	9/29/97
13	Revocation of Prior Powers of Attorney, and new Power of Attorney with Certificate Under 37 C.F.R. §3.73(b)	11/19/97
14	Office Action [Re: Change in Counsel]	12/01/97
15	Appeal Brief	1/27/98
16	Notification of Non-Compliance with 37 C.F.R. §1.192(c)	3/27/98
17	Response to Notification of Non-Compliance with 37 C.F.R. §1.192(c)	4/27/98
18	Notice of Change in Address	5/01/98
19	Revocation of Previous Powers of Attorney and Appointment of New Attorneys	7/8/98
20	Examiner's Answer	9/01/98
21	Request for Oral Hearing	11/02/98

DEMOORE ATTORNEY AT LAW

<u>Item No.</u>	<u>Description</u>	<u>Filing Date</u>
22	Appellant's Reply Brief	11/13/98
23	PTO Letter Acknowledging Substitution of Attorneys	11/18/98
24	PTO Letter Acknowledging Entry of Reply Brief	11/23/98
25	PTO Jacket Information on Serial No. 08/435,798 as of 6/2/2000	

II. File Wrapper, Serial No. 08/538,422 Filed October 2, 1995

<u>Item No.</u>	<u>Description</u>	<u>Filing Date</u>
26	PTO Prosecution History Jacket for '422 Application (face of file, contents flap, index of claims, PTO 270, searched)	
27	Patent Application and Related Transmittal Filing Papers	10/02/95
28	Information Disclosure Statement	6/24/96
29	Supplemental Information Disclosure Statement	6/26/96
30	Office Action	1/09/97
31	Revocation of Prior Powers of Attorney and New Powers of Attorney	6/16/97
32	Response from PTO to the Powers of Attorney	6/17/97
33	Power to Inspect and Make Copies	6/20/97
34	Amendment	c. 7/9/97
35	Final Office Action	c. 10/28/97
36	Notice of Appeal	1/28/98
37	Notice of Change of Correspondence Address	4/01/98
38	Revocation of Previous Powers of Attorney and Appointment of New Attorney	7/08/98
39	Appointment of Associate Attorney	7/17/98
40	Communication from PTO Enclosing Defective Notice of Appeal or Brief and Notice of Abandonment	7/31/98

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<u>Item No.</u>	<u>Description</u>	<u>Filing Date</u>
41	Petition for Delayed Response	8/19/98
42	Response from PTO to the Powers of Attorney filed 7/13/98	10/02/98
43	Notice of Withdrawal, Abandonment and Attachment	c. 3/2/99

III. File Wrapper, CIP Serial No. 09/136,901 Filed August 19, 1998

<u>Item No.</u>	<u>Description</u>	<u>Filing Date</u>
44	CIP Patent Application and Related Filing Papers - Ser. No. 09/136,901	8/19/98
45	Preliminary Amendment	8/19/98
46	Notice to File Missing Parts of Application - Filing Date Granted	10/01/98
47	Completion of Filing Requirements - Nonprovisional Application	11/5/98
48	Transmittal of Information Disclosure Statement	c. 3/22/99
49	Notice of Allowability and Issue Fee Due	3/29/99
50	Request for Consideration of Applicant Supplied Information	c. 4/23/99
51	Communication from PTO Acknowledging IDS Filed 3/22/99	4/27/99
52	Transmittal of Formal Drawings	5/24/99
53	Comment on Statement of Reasons for Allowance	6/24/99
54	Issue Fee Transmittal	6/28/99
55	Supplemental Information Disclosure Statement	6/28/99
56	Communication from PTO re: IDS filed 7/1/99 and Corrected Notice of Allowability and Referral of Entry of U.S. Pat. 5,630,363 - PTO-1449 From	8/25/99
57	Issued U.S. Patent No. 5,960,713	10/05/99